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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,341	08/03/2000	Suzanne M. Jordan	END9 2000 0041 US1	9659
44755	7590	01/13/2005	EXAMINER	
SHELLEY M. BECKSTRAND 61 GLENMONT ROAD WOODLAWN, VA 24381			PORTER, RACHEL L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/632,341

Applicant(s)

JORDAN ET AL.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,6-11,16-19,22,23 and 26 is/are allowed.
- 6) ☒ Claim(s) 3-5,12-15,24,25 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment received 10/21/04. Claims 1-19 and 22-27 are pending.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/21/04 has been entered.

***Claim Objections***

3. Claim 6 is objected to because of the following informalities: Claim 6 recites "measurers" instead of "measures", in line 36. Examiner Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 27 recites a program storage device embodying instructions executable by a machine to perform a series of steps. The first two steps recited in the claim include "articulating envisioned business goals" and "enumerating and defining behaviors and goals satisfied by said behaviors..." While the preamble indicates that a machine performs these steps, the specification does not describe how these steps are performed, and it is respectfully submitted that one of ordinary skill in the art would not have understood how to have a machine articulate envisioned business goals and enumerate and define behaviors and goals to satisfy these goals without undue experimentation.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-5, 12-15, 24-25, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "selecting as said metrics those which also satisfy related measures" in lines 3-4. Although the claim recites measurement models and metrics, it does not reference or recite a measure or measures. Therefore, it is unclear to the Examiner which "related measures" are being referenced in claim 3, and how the

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“related measures” are distinct from the metrics recited throughout the claim. The Examiner suggests the use of consistent terminology throughout the claim to refer the same elements (i.e. using the term measure or measurement or metric, rather than using these terms interchangeably.)

Similarly, claim 4 recites “customer goals to achieve through measurements” in lines 4-5, and also recites measures that relate to behaviors throughout the previously amended claim language. However, the newly amended language (lines 20-26 and lines 29-35) recites the relationship of each “metric” to a behavior. Therefore, it is unclear from the current claim language whether the measures and measurements previously recited are equivalent to the “metrics” recited in the amended claim language, or how the “metrics” are distinct from the measures recited throughout the claim. The Examiner suggests the use of consistent terminology throughout the claim to refer the same elements (i.e. using the term measure or measurement or metric, rather than using these terms interchangeably.) However, the Examiner has interpreted the terms “measure” and “metric” to be equivalent.

Claim 5 inherits the deficiencies of claim 5 through dependency, and is also rejected.

Claim 12 currently recites the step of “validating assumptions and behavioral expectations in said measurement solutions.” There is insufficient antecedent basis for this limitation of this in the claim. More specifically, the claim does not previously mention assumptions or behavioral expectations (in association with the measurement

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solution). Therefore, it is unclear to the Examiner which assumptions or behavioral expectations are being referenced.

Claims 13-15 inherit the deficiencies of claim 12 through dependency and are also rejected.

Claim 24 recites "contract measurement" and measurement models throughout the previously amended claim language. However, the newly amended language (lines 19-25 and lines 28-35) recites the relationship of each "metric" to a behavior and each metric to other metrics. Therefore, it is unclear from the current claim language whether the measurements previously recited are equivalent to the "metrics" recited in the amended claim language, or how the "metrics" are distinct from the measurements recited throughout the claim. The Examiner suggests the use of consistent terminology throughout the claim to refer the same elements (i.e. using the term measure or measurement or metric, rather than using these terms interchangeably.) However, the Examiner has interpreted the terms "contract measurement" and "metric" to be equivalent.

Claim 25 currently recites the step of "validating assumptions and behavioral expectations in said measurement solutions." There is insufficient antecedent basis for this limitation of this in the claim. More specifically, the claim does not previously mention assumptions or behavioral expectations (in association with the measurement solution). Therefore, it is unclear to the Examiner which assumptions or behavioral expectations are being referenced.

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Claim 27 recites a program storage device with instructions for performing steps including "articulating envisioned business goals and behaviors" and "enumerating envisioned business goals and behaviors..." While the preamble indicates that a machine performs these steps, it is unclear to the Examiner how these steps would be performed by a machine for the reasons provided in the rejection of claim 27 under 35 U.S.C. 112, 1<sup>st</sup> in the present Office Action.

***Allowable Subject Matter***

8. Claims 1, 6-7, 8-11, 16, 17, 18, 19, 22, 23, and 26 are allowable.

9. Claims 3-5, 12-15, 24-25, and 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claim 27 must also overcome the rejection under 35 U.S.C. 112, first paragraph set forth in this Office action.

10. The following is a statement of reasons for the indication of allowable subject matter:

11. The closest prior art of record Davis et al ("The Information System Consultant's Handbook: Systems Analysis and Design", CRC Press) and Feurer et al ("Performance Measurement in Strategic Change") in view Nagai teach a system and method for identifying customer/organization goals, mapping behaviors to measures (i.e. metrics), relating different measures to one another and building models. However, the closest

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prior art of record does not teach or fairly suggest in the specific manner and combinations recited in independent claims 1,4,6,8,10,12,16-19,22-27:

- 1) building measurement model work product by building a first draft measurement model and a second draft measurement model;
- 2) building the first draft measurement model by selectively executing a first prioritization process and a second prioritization process, wherein the first prioritization process determines for each measure a relationship with each behavior satisfied by the measure and wherein the second prioritization process determines for each measure a relationship with each other measure; and
- 3) building said second draft measurement model by selecting measures prioritized selectively by behaviors satisfied and related measures.

Moreover, the closest prior art of record does not disclose or fairly suggest the details of developing multiple tables in the first and second prioritization processes, determining for each metric/measure a subtotal representing how each metric in a give a category relates to other metrics/ measures and prioritizing these behaviors as desirable for constructing a second draft measurement model.

The dependent claims incorporate the allowable subject matter of their respective independent claims, through dependency, and are also allowable for the same reasons.

### ***Claim Rejections - 35 USC § 103***

12. The rejection of claims 1-7, 10-17, and 22-26 under 35 U.S.C. 103(a) as being unpatentable over Davis et al. ("The Information System Consultant's Handbook:



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Systems Analysis and Design", CRC Press) in view of Feurer et al ("Performance Measurement in Strategic Change") is hereby withdrawn due to the amendment filed 10/21/04.

13. The rejection of claims 8-9, 18-19, and 27 under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Nagai et al. (US 2001/0025247 A1) and in further view of Feurer is hereby withdrawn due to the amendment filed 10/21/04.

### ***Response to Arguments***

14. Applicant's arguments, filed 10/21/04, with respect to newly added claim language have been fully considered and are persuasive. The art rejection of claims 1-19 and 22-27 has been withdrawn.

### ***Conclusion***

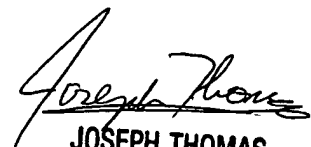
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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